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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,635	10/02/2003	Kevin J. Rapp	08215-504001 / P88-026569	4183
28863 7590 05/21/2008 SHUMAKER & SIEFFERT, P. A. 1625 RADIO DRIVE SUITE 300 WOODBURY, MN 55125			EXAMINER OGDEN JR, NECHOLUS	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 05/21/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pairedocketing@ssiplaw.com

Office Action Summary	Application No. 10/677,635	Applicant(s) RAPP ET AL.	
	Examiner Necholus Ogden	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413) |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) ☐ Information Disclosure Statement(s) (PTO/SB/08) | 5) ☐ Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant has canceled claims 45-46.

1. Claims 47-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McShane et al (6,398,986).

McShane et al disclose a dielectric fluid composition and a method of retro-filling, comprising a vegetable oil based fluid that maybe admixed with an additional oil blend such as mineral oil wherein said blend of mineral oil comprises less than 50% by weight and other additives such as antioxidants and pour point depressants (col. 4, lines 53-67). McShane et al further teach that said fluid is used in electrical transformers that frequently wrapped with cellulose material or paper (col. 9, lines 43-62).

As this reference teaches all of the instantly required it is considered anticipatory.

In the alternative, McShane is silent with respect to inhibiting breakdown of said paper material in dielectric fluids. However, this limitation would have been inherent to the compositions of McShane et al because McShane et al teach the preferred components in their requisite proportions for the purpose of immersing dielectric fluid in paper insulated equipment.

2. Claims 47-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McShane et al (6,613,250).

McShane et al disclose a dielectric fluid composition and a method of retro-filling comprising a vegetable oil based fluid that maybe admixed with an additional oil blend such as mineral oil wherein said blend of mineral oil comprises less than 50% by weight

Art Unit: 1796

and other additives such as pour point depressants and antioxidant materials (col. 4, lines 53-67). McShane et al further teach that said fluid is used in electrical transformers that frequently wrapped with cellulose material or paper (col. 9, lines 44-65).

As this reference teaches all of the instantly required it is considered anticipatory. In the alternative, McShane et al is silent with respect to inhibiting breakdown of said paper material in dielectric fluids. However, this limitation would have been inherent to the compositions of McShane et al because McShane et al teach the preferred components in their requisite proportions for the purpose of immersing dielectric fluid in paper insulated equipment.

3. Claims 45-46 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Goedde et al (6,726,857) are withdrawn in view of applicants amendment.

Response to Arguments

4. Applicant's arguments filed 1-17-2008 have been fully considered but they are not persuasive.

5. Applicant argues that McShane et al do not teach each and every element of the claimed invention, because he alleges that McShane does not suggests a dielectric fluid having mineral oil in a major amount and vegetable oil in an amount from 5-25%.

6. The examiner contends and respectfully disagrees because applicant's claims do not call out that the mineral oil must be in a major amount as argued and further applicant's claims have a transitional phrase that is open to include additional

ingredients that are not specified in the claimed invention. Moreover, McShane teaches that mineral oil is present in less than 50%, which when combined with other ingredients such vegetable oil, antioxidants and adjuncts could present mineral oil in a major amount of his composition and therefore anticipate the claimed invention.

7. Applicant argues that McShane fails to teach or suggest extending the service life of the paper as claimed.

8. The examiner contends and respectfully disagrees since McShane teaches cellulose paper as a material in the electrical device that comprises his dielectric fluid and the dielectric fluid is anticipated, then the functional language of extending the service life of the paper would be an inherent function since the composition which is used to insulate said paper and allegedly extends the service life of said paper is anticipated by McShane.

9. Applicant argues that McShane et al has not reasonable chance of success.

10. The examiner contends that this statement is considered nothing more than an attorney's argument that is not founded by factual evidence and therefore is considered a conclusory statement and given little patentable weight.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 1796

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Necholus Ogden/
Primary Examiner
Art Unit 1796

Application/Control Number: 10/677,635
Art Unit: 1796

Page 6

5-17-2008